

REMARKS

Claims 40-44 were pending in this application.

Claims 40-44 have been rejected.

No claims have been amended.

Claims 45-59 have been added.

Claims 40-59 are now pending in this application.

Reconsideration and full allowance of Claims 40-59 are respectfully requested.

I. REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects Claims 40-44 under 35 U.S.C. § 102(b) as being anticipated by March et al., “Safety of High-Energy Neodymium:YAG Laser Pulses in YAG Sclerostomy” (“*March*”). This rejection is respectfully traversed.

A prior art reference anticipates a claimed invention under 35 U.S.C. § 102 only if every element of the claimed invention is identically shown in that single reference, arranged as they are in the claims. (*MPEP* § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. (*MPEP* § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985)).

Claim 40 recites irradiating the sclera of an eye “in a region of a ciliary body” to “thereby weaken the sclera of the eye” and “increase an effective working distance of a ciliary muscle of the

eye.”

March simply recites a technique for using laser pulses to form a “new channel for drainage of aqueous humor” in order to treat glaucoma. (Page 584, Left column, Introduction). In other words, *March* simply indicates that laser pulses can be used to form channels completely through the sclera of an eye. *March* lacks any mention of using the laser pulses “in a region of a ciliary body” as recited in Claim 40. *March* also lacks any mention that the laser pulses are used to “weaken the sclera of the eye” and “increase an effective working distance of a ciliary muscle of the eye” as recited in Claim 40.

To establish inherency, the burden is on the Patent Office to present evidence clearly showing that “the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” (MPEP § 2112). However, the fact that a “certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” (MPEP § 2112). The Patent Office must “provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows” from the teachings of cited reference. (MPEP § 2112).

The Office Action contains no explanation as to how or why *March* must inherently disclose irradiating the sclera of an eye “in a region of a ciliary body.” The Office Action also contains no explanation as to how or why *March* must inherently disclose irradiating the sclera of an eye to thereby “weaken the sclera of the eye” and “increase an effective working distance of a ciliary muscle of the eye” as recited in Claim 40.

For these reasons, *March* fails to anticipate the Applicant's invention as recited in Claim 40 (and its dependent claims). Accordingly, the Applicant respectfully requests withdrawal of the § 102 rejection and full allowance of Claims 40-44.

II. DOUBLE PATENTING REJECTION

The Office Action rejects Claims 40-44 under the judicially created doctrine of obviousness type double patenting. In particular, the Office Action rejects Claims 40-44 as being unpatentable over U.S. Patent No. 5,489,299, U.S. Patent No. 5,503,165, U.S. Patent No. 5,489,299 in view of Sand, and U.S. Patent No. 5,503,165 in view of Sand. The Applicant respectfully traverses these rejections.

This application claims priority (through one other application) to Application Serial No. 08/462,649, which is a divisional of Application Serial No. 08/139,756 (now U.S. Patent No. 5,489,299). Because this application represents a continuation (or continuation-in-part) of a divisional application from U.S. Patent No. 5,489,299, this application should not be rejected under the judicially created doctrine of obviousness type double patenting in view of U.S. Patent No. 5,489,299.

Similarly, Application Serial No. 08/462,655 (now U.S. Patent No. 5,503,165) claims priority as a divisional to U.S. Patent No. 5,354,331. U.S. Patent No. 5,489,299 (to which this application claims priority) also represents a divisional of U.S. Patent No. 5,354,331. Because U.S. Patent No. 5,503,165 and U.S. Patent No. 5,489,299 both claim priority as separate divisionals from U.S. Patent

No. 5,354,331, this application should not be rejected under the judicially created doctrine of obviousness type double patenting in view of U.S. Patent No. 5,503,165.

In addition, the claims of this application are not obvious variations of the subject matter claimed in U.S. Patent No. 5,503,165. All of the independent claims in U.S. Patent No. 5,503,165 recite “decreasing the length of the zonules.” Claim 40 recites “irradiating a sclera of an eye in a region of a ciliary body.” The Office Action has not explained how irradiating a sclera in a region of a ciliary body represents an obvious variation of decreasing the length of zonules in the eye. In particular, these claims involve different structures of the eye and different functions (irradiating to weaken the sclera versus decreasing zonule length).

For these reasons, the Applicant respectfully requests withdrawal of the double patenting rejections and full allowance of Claims 40-44.

III. NEW CLAIMS

The Applicant has added new Claims 45-59. The Applicant respectfully submits that no new matter has been added. The Applicant respectfully requests entry and full allowance of Claims 45-59.

IV. CONCLUSION

The Applicant respectfully submits that all pending claims are in condition for allowance and respectfully requests full allowance of all pending claims.

SUMMARY

If any issue arises, or if the Examiner has any suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at wmunck@munckbutrus.com.

The Commissioner is hereby authorized to charge any fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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